

**AMENDMENTS TO THE DRAWINGS**

Two (2) replacement sheets of Figures 4 and 5 are attached following page of this paper.

FIG. 4 has been amended to show that item 407 is the "media user guide interface" and item 411 is "Kid's Pictures." Support may be found in ¶¶ 72-74 of the present application.

Fig. 5 has been amended to correctly show that the first party 501 performs step C, in accordance with the disclosure in ¶76 of the present application. The Applicant submits that no new matter has been added by the Replacement Sheet of Figure 5.

**REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. By this Amendment, claims 1-6, 8-16, 18-21, 23-24, 26, 28, and 31 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 9-13, 19-23, and 29-31 stand rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2002/0184631, issued to Cezeaux, et al. (hereinafter, Cezeaux). Claims 4-8, 14-18, and 24-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cezeaux, in view of U.S. Patent Application Publication No. 2002/0059621, issued to Thomas, et al. (hereinafter, Thomas). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

**I. Information Disclosure Statement**

The Examiner states the following in page 2 of the Office Action:

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references

have been cited by the examiner on form PTO-892, they have not been considered. Incorporated references (Attorney Docket No. 14185US02, Attorney Docket No. 14274US02 & Application No.60/465,982) are disclosed in paragraph [02] of the specification.

The Applicant points out that it is believed that none of the references cited in the cross-reference section (or any other section that incorporates an application by reference) of the present application qualify as prior art to the present application. In instances where a cross-reference section was used (or any other section which incorporates an application by reference), the Applicant points out that the Examiner was simply being notified of applications that may be considered related to the present application (e.g., including at least one common inventor and/or a common disclosure with the present application). Therefore, it is believed that none of the references cited in the cross-reference section (or in any other section that incorporates by reference) need be cited in an IDS.

## **II. Specification**

The specification was objected to for various informalities. The Applicant has amended the specification, as set forth above, to overcome this objection.

The specification was also object to as failing to provide proper antecedent basis for the claimed subject matter. The Office Action further states:

Correction of the following is required: The specification does not distinctly define the characteristics of each of the claimed processors of Claim 31: a media processing system processor, a media management system processor, a computer processor, a media exchange software processor and a media peripheral processor (paragraphs [11] & [96]). Without further disclosure as to the distinctness of each claimed processor in Claim 31, each claimed processor will be treated as indistinguishable and therefore the broadest reasonable interpretation of a processor will be used in the interpretation of Claim 31.

See the Office Action at page 3. The Applicant respectfully disagrees and points out that the various types of processors stated in claim 31 are stated in paragraph 96 of the specification. In addition, the Applicant submits that it is known in the art what the terms "media peripheral", "computer", and a "storage system" mean. Therefore, the Applicant submits that there is no need for further clarification of the terms "media peripheral processor", "computer processor", and a "storage system processor." With regard to the terms "media processing system (MPS)" and "media exchange software (MES)", the Applicant submits that the specification is sufficiently informative as to the meaning of these terms. For example, the Examiner is referred to Figures 1A-3 and the corresponding description in paragraphs 29-71 for additional information on what is meant by "media processing system (MPS)" and "media exchange software (MES)". Obviously, a "media processing system (MPS) processor" and a "media exchange software (MES) processor" would be a processor that performs one or more of the

functionalities of a “media processing system (MPS)” and a “media exchange software (MES)”, as already described in the specification.

The Applicant respectfully requests that the objections to the Specification be withdrawn.

### **III. Claim 22**

The Applicant points out that claim 22 was inadvertently omitted from the claims section at the time of filing of the present application. The Applicant has amended the claims, as set forth above, to introduce the inadvertently omitted claim 22 as a new claim. The Applicant submits that new claim 22 is similar in many respects to corresponding claims 2 and 22. The Applicant also submits that no new matter has been introduced by the new claim 22.

### **IV. Drawings**

The drawings (FIGS. 4 and 5) were objected to because of incorrect labeling.

FIG. 4 has been amended to show that item 407 is the “media user guide interface” and item 411 is “Kid’s Pictures.” Support may be found in ¶¶ 72-74 of the present application.

Fig. 5 has been amended to correctly show that the first party 501 performs step C, in accordance with the disclosure in ¶¶ 79-80 of the present application. The Applicant submits that no new matter has been added by the Replacement Sheet of Figure 5.

#### **REJECTION UNDER 35 U.S.C. § 102**

##### **IV. Cezeaux Does Not Anticipate Claims 1-3, 9-13, 19-23, and 29-31**

The Applicant now turns to the rejection of claims 1-3, 9-13, 19-23, and 29-31 under 35 U.S.C. 102(a) as being anticipated by Cezeaux. With regard to the anticipation rejections under 102(a), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

###### **A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(a)**

With regard to the rejection of independent claim 1 under 102(a), the Applicant submits that Cezeaux does not disclose or suggest at least the limitation of “receiving at a second location, said media from a storage location other than

said non-broadcast channel provider," as recited by the Applicant in independent claim 1. The Office Action states the following:

With respect to Claim 1, the claimed "generating a request from first location to receive media from a non-broadcast channel provider" is met by Cezeaux et al. that teach a subscriber, using a set top box 102 at a first location, requesting media from a content server 105, which in turn may allow the subscriber to view media such as pay-per-view movies (Fig. 1&4; paragraphs [0026], [0029], [0030], & [0035]). The claimed "providing at least one of payment and authorization information to said non-broadcast channel provider" is met by Cezeaux et al. that teach user authentication upon a request for media from a content server (Fig.3&4, paragraphs [0026], [0030], [0034] & [0035]). The claimed "receiving said media from a storage location other than said non-broadcast channel provider" is met by Cezeaux et al. that teach the transmittal of requested media to a subscriber from content sources 101 (Fig.1; paragraph [0030]).

See Office Action at page 5. Referring to FIG. 1 of Cezeaux, the Applicant points out that a subscriber at a first location may request media via the set-top-box 102. The media may be delivered from the content sources 101 via the content server 105. **However, the Applicant points out that the content is delivered back to the user at set-top-box 102, where the request for the media originated.** In this regard, Cezeaux does not disclose or suggest at least the limitation of "receiving at a second location, said media from a storage location other than said non-broadcast channel provider," as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Cezeaux and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-3, 9-10, 12-13, 19-20, 23, and 29-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(a) as being anticipated by Cezeaux has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-3, 9-10, 12-13, 19-20, 23, and 29-31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-3, 9-10, 12-13, 19-20, 23, and 29-31.

**REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...," citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**V. The Proposed Combination of Cezeaux and Thomas Does Not Render Claims 4-8, 14-18, and 24-28 Unpatentable**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(a) as being anticipated by Cezeaux has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Thomas) does not overcome the deficiencies of Cezeaux, claims 4-8, 14-18, and 24-28 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4-8, 14-18, and 24-28.

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**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 20-MAR-2008

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